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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,385	09/28/2001	Mark Kirkpatrick	BS01-170	2337
28970	7590	08/19/2004	EXAMINER	
SHAW PITTMAN IP GROUP 1650 TYSONS BOULEVARD SUITE 1300 MCLEAN, VA 22102			ENG, GEORGE	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/964,385	<b>Applicant(s)</b> KIRKPATRICK, MARK	
	<b>Examiner</b> George Eng	<b>Art Unit</b> 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/101,630. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations, i.e., a battery and a sound generating device, are transparently found in the copending Application No. 10/101,630 with obvious wording variations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-10, 12-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al. (US PAT. 5,251,329 hereinafter Takagi) in view of Makela et al. (US PAT. 6,501,967 hereinafter Makela).

Regarding claim 1, Takagi discloses a battery assembly (15, figure 3) for a cellular telephone (1, figure 3) comprising a battery (16, figure 4) for providing power to the cellular telephone (col. 5 lines 30-36) and a ringer device (25, figure 11), i.e., a sound generating device, attached to the battery, wherein the ringer device is triggered to play sound upon detection of a telephone call by the cellular telephone (col. 8 line 26 through col. 9 line 20). Takagi differs from the claimed invention in not specifically teaching the ringer device comprising memory for storing a sound file so that the ringer device is triggered to play sound associated with the sound file. However, Makela teaches a sound generating device for generating ringing tone as a response to an incoming call comprising a memory (12, figure 4) for storing signal representing the ringing tone, i.e., a sound file, so that the sound generator (15, figure 4) triggers to play tone associated with signal stored in the memory upon detection of a call (abstract and col. 5 line 30 through col. 6 line 51) in order to make user friendly by allowing a telephone user to produce a ringing tone to his/her liking. Therefore, it would have been obvious to a person of ordinary skill

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in the art at the time the invention was made to modify Takagi in having the ringer device comprising memory for storing a sound file so that the ringer device is triggered to play sound associated with the sound file, as per teaching of Makela, because it makes user friendly so that each user is allowed to produce a desired ringing tone to his/her liking.

Regarding claim 2, Makela discloses the sound generator storing a plurality of sound files, wherein each sound file can be being designated as an audio alert for the telephone (col. 5 lines 30-36).

Regarding claim 3, Makela teaches to use external user interface in electrical communication the sound generator with a computer to provide external access to the plurality of sound files in the sound generator (col. 5 lines 36-40).

Regarding claim 5, Takagi discloses a battery assembly (15, figure 3) for a cellular telephone (1, figure 3) comprising a battery (16, figure 4) for providing power to the cellular telephone (col. 5 lines 30-36) and a ringer device (25, figure 11), i.e., a sound generating device, attached to the battery, wherein the ringer device is triggered to play sound upon detection of a telephone call by the cellular telephone (col. 8 line 26 through col. 9 line 20). Takagi differs from the claimed invention in not specifically teaching the ringer device comprising memory for storing a sound file so that the ringer device is triggered to play sound associated with the sound file, an external connector socket on the battery in electrical communication with the sound generating device to provide external access to the plurality of sound files in the sound generating device, and a selector device on the battery for designating a sound file to use as an audio alert signal. However, Makela teaches a sound generating device for generating ringing tone as a response to an incoming call comprising a memory (12, figure 4) for storing signal

representing the ringing tone, i.e., a sound file, so that the sound generator (15, figure 4) triggers to play tone associated with signal stored in the memory upon detection of a call, an external user interface for providing external access to the memory in the sound generating device, and a user interface for designating a tone, i.e., a sound file, to use as an audio alert signal (abstract and col. 5 line 30 through col. 6 line 51) in order to make user friendly by allowing a telephone user to produce a ringing tone to his/her liking. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Takagi in having the ringer device comprising memory for storing a sound file so that the ringer device is triggered to play sound associated with the sound file, the external connector socket on the battery in electrical communication with the sound generating device to provide external access to the plurality of sound files in the sound generating device, and the selector device on the battery for designating a sound file to use as an audio alert signal, as per teaching of Makela, because it makes user friendly so that each user is allowed to produce a desired ringing tone to his/her liking.

Regarding claim 6, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 7, Takagi discloses cellular telephone system comprising a cellular telephone body (1, figure 3), and a battery assembly (15, figure 3) connected with the cellular telephone body, the battery assembly including a battery (16, figure 4) for providing power to the cellular telephone (col. 5 lines 30-36) and a ringer device (25, figure 11), i.e., a sound generating device, attached to the battery, wherein the ringer device is triggered to play sound upon detection of a telephone call by the cellular telephone (col. 8 line 26 through col. 9 line 20). Takagi differs from the claimed invention in not specifically teaching the ringer device

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comprising memory for storing a sound file so that the ringer device is triggered to play sound associated with the sound file. However, Makela teaches a sound generating device for generating ringing tone as a response to an incoming call comprising a memory (12, figure 4) for storing signal representing the ringing tone, i.e., a sound file, so that a sound generator (15, figure 4) triggers to play tone associated with signal stored in the memory upon detection of a call (abstract and col. 5 line 30 through col. 6 line 51) in order to make user friendly by allowing a telephone user to produce a ringing tone to his/her liking. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Takagi in having the ringer device comprising memory for storing a sound file so that the ringer device is triggered to play sound associated with the sound file, as per teaching of Makela, because it makes user friendly so that each user is allowed to produce a desired ringing tone to his/her liking.

Regarding claim 8, Makela teaches the sound generator storing a plurality of sound files that are capable of being edited (col. 6 lines 40-44).

Regarding claims 9-10, the limitations of the claims are rejected as the same reasons set forth in claim 3.

Regarding claim 12, the limitations of the claim are rejected as the same reasons set forth in claim 7.

Regarding claims 13-14, the limitations of the claims are rejected as the same reasons set forth in claim 3.

Regarding claim 16, Takagi discloses cellular telephone system comprising a cellular telephone body (1, figure 3), and a battery assembly (15, figure 3) connected with the cellular



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telephone body, the battery assembly including a battery (16, figure 4) for providing power to the cellular telephone (col. 5 lines 30-36) and a ringer device (25, figure 11), i.e., a sound generating device, attached to the battery, wherein the ringer device is triggered to play sound upon detection of a telephone call by the cellular telephone (col. 8 line 26 through col. 9 line 20). Takagi differs from the claimed invention in not specifically teaching the ringer device comprising memory for storing a sound file so that the ringer device is triggered to play sound associated with the sound file, an external connector socket on the battery in electrical communication with the sound generating device to provide external access to the plurality of sound files in the sound generating device, a computer system having an electrically connected to the sound generating device through the connector socket for editing the plurality of sound files by adding or delete from the sound generating device and a selector device on the battery for designating a sound file to use as an audio alert signal. However, Makela teaches a sound generating device for generating ringing tone as a response to an incoming call comprising a memory (12, figure 4) for storing signal representing the ringing tone, i.e., a sound file, so that a sound generator (15, figure 4) triggers to play tone associated with signal stored in the memory upon detection of a call, an external user interface coupled to an external computer system for providing external access to the memory in the sound generating device to edit the plurality of tones, and a user interface for designating a tone, i.e., a sound file, to use as an audio alert signal (abstract and col. 5 line 30 through col. 6 line 51) in order to make user friendly by allowing a telephone user to produce a ringing tone to his/her liking. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Takagi in having the ringer device comprising memory for storing a sound file so that the ringer device is

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triggered to play sound associated with the sound file, as per teaching of Makela, because it makes user friendly so that each user is allowed to produce a desired ringing tone to his/her liking.

Regarding claim 17, the limitations of the claim are rejected as the same reasons set forth in claim 16.

Regarding claims 18, the limitations of the claim are rejected as the same reasons set forth in claim 16.

Regarding claim 19, Makeleat teaches to couple the telephone with a computer, i.e., a personal data assistant, via the external user interface for inputting ringing tone (col. 5 lines 36-40).

5. Claims 4, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al. (US PAT. 5,251,329 hereinafter Takagi) in view of Makela et al. (US PAT. 6,501,967 hereinafter Makela) as applied to claims above, and further in view of Haraguchi (US PAT. 6,597,279).

Regarding claim 4, Makela teaches to use the user interface for designating a tone, i.e., a sound file, to use as an audio alert signal (col. 5 lines 32-36). The combination of Takagi and Makela differs from the claimed invention in not specifically teaching the user interface for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal. However, Haraguchi teaches a simplified method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial for scrolling through the plurality of sound files and designating a sound file to use as an audio alert

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signal (col. 5 lines 16 through col. 6 line 34) in order to simplify the operation of setting the incoming tone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Takagi and Makela in having he user interface for scrolling through the plurality of sound files and designating a sound file to use as an audio alert signal, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the incoming tone.

Regarding claims 11 and 15, the limitations of the claims are rejected as the same reasons set forth in claim 4.

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al. (US PAT. 5,251,329 hereinafter Takagi) in view of Haraguchi (US PAT. 6,597,279).

Regarding claim 20, Takagi discloses a method comprising the steps of providing a battery assembly (15, figure 12) for a cellular telephone (1, figure 12), the battery assembly including a ringer device, i.e., sound generating device, for playing sound upon detection of a telephone call by the cellular telephone (col. 8 line 26 through col. 9 line 20). Takagi differs from the claimed invention in not specifically teaching the ringer device being programmable comprising a selector and a plurality of sound files so that a designated audio alert signal can be selected by scrolling through the plurality of sound files with the selector to hear the plurality of sound files, listening to exemplary sounds and selecting a selected sound from the plurality of sound files. However, Haraguchi teaches a method for setting an incoming tone to be output from a speaker when a signal is received by an operation comprising a jog dial (9, figure 1), i.e., a selector, and a memory (7, figure 1) for storing a plurality of sound files so that a designated

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audio alert tone can be simply selected by scrolling through the plurality of sound files with the jog dial to hear the plurality of sound files, listening to exemplary sounds and selecting the designated audio alert signal (col. 3 line 24 through col. 6 line 51) in order to simplify the operation of setting the favorite incoming tone by a user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Takagi in having the ringer device being programmable comprising a selector and a plurality of sound files so that a designated audio alert signal can be selected by scrolling through the plurality of sound files with the selector to hear the plurality of sound files, listening to exemplary sounds and selecting a selected sound from the plurality of sound files, as per teaching of Haraguchi, because it makes user friendly by simplifying the operation of setting the favorite incoming tone by user.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miyashita (US PAT. 6,244,894) discloses a cellular phone battery equipped with IC card (abstract). Usui et al. (US PAT. 6,298,245) discloses an IC card type radio communication device including a storage unit, a sound input unit, a sound output unit and interface unit for maintaining a compatibility of interface for traditional data communication (col. 1 line 63 through col.4 line 52). Armanto et al. (US PAT. 6,094,587) discloses a method for programming a ringing tone of a telephone (abstract).

8. Any response to this action should be mailed to:

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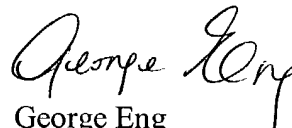
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Arlington, V.A., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



George Eng  
Primary Examiner  
Art Unit 2643